

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before issuing any further action on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, both the undersigned and Darren Kang would like to thank Examiner Lastra for the courtesies extended during the telephone interview on October 21, 2009. (referred to as "the telephone interview") The telephone interview is summarized here.

Telephone Interview Summary

This statement summarizes the issues discussed during the October 21, 2009 telephone interview. Further, this Telephone Interview Summary is presented in the format suggested in M.P.E.P. § 713.04 by the Patent Office.

Date of Interview: October 21, 2009

Type of Interview: Telephonic Conference

Name of Participant(s):

- Examiner: Daniel LASTRA
- For Applicants: John C. POKOTYLO
Darren KANG

A. Exhibit(s)/Demonstration(s):

- None

B. Claims discussed:

- 1, 34, 40 and 45

C. Reference(s):

- International Publication No.
WO 02/25507 ("the Werkhoven publication")

D. Proposed Amendments:

- The Examiner suggested clarifying the invention by amending certain claim features to overcome the Werkhoven publication.

E. Principal Arguments:

- The applicants' representatives described embodiments consistent with the invention of claims 1, 34, 40 and 45 (with reference to Figure 5), their understanding of the teachings of the Werkhoven publication, and the differences between the claimed invention and the teachings of the cited reference.

F. Other Pertinent Matters:

- None.

G. General Results/Outcome:

- The Examiner agreed that amending the claims to highlight the distinguishing features as discussed would be helpful in distinguishing the claimed invention over the cited art. He also stated that upon receipt and review of the amended set of claims, a further search may be warranted.

Rejections under 35 U.S.C. § 102

Claims 1-23, 25-38, 40-69 and 71-92 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Werkhoven publication. (The applicants canceled claim 39 in a prior reply.) The applicants respectfully request that the Examiner withdraw this ground of rejection in view of the following.

Independent claim 1, as amended, is not anticipated by the Werkhoven publication at least because the Werkhoven publication does not teach a combination of (1) **generating, by the web-based e-mail serving system, a first ad request** for at least one ad relevant to the e-mail content, the first ad request including information of the e-mail content and the request identifier, (2) **transmitting, by the web-based e-mail serving system, the first ad request to a content-relevant ad serving system,** (3) **receiving, responsive to the transmitted first ad request and by the web-based e-mail serving system, at**

least one ad relevant to the e-mail content in association with the request identifier from the content-relevant ad serving system, (4) storing, by the web-based e-mail serving system, the received at least one ad in association with the request identifier, (5) accepting, by the web-based e-mail serving system, a second ad request from the client device, the second ad request including the request identifier, (6) reading, by the web-based e-mail serving system, the stored at least one ad using the request identifier included in the second ad request, and (7) serving to the client device, by the web-based e-mail serving system, the at least one ad read, in combination with other features of claim 1.

In rejecting claim 1, the Examiner contends that page 3, lines 10-15 and lines 30-35 and page 9, lines 1-10 of the Werkhoven publication teach all of the features of previously presented claim 1. However, unlike the claimed invention which includes **both a content relevant ad serving system and a separate web-based e-mail serving system**, the Werkhoven publication discloses a **single** server. (See, e.g., element 3 of Figure 1.) Consequently, the single server 3 of the Werkhoven publication would not include the series of operations claimed. That is, exemplary web-based email serving systems consistent with the invention of independent claim 1 interact with a content-relevant ad serving system, precluding any interpretation of a single server 3 which provides both the electronic mail and the push-content material.

Thus, claim 1, as amended, is not anticipated by the Werkhoven publication for at least this reason. Claims 34, 40, 45, 47, 80, 86 and 91, as amended, are similarly

not anticipated by the Werkhoven publication. Since claims 2-6, 8, 10-12 and 15-18 directly or indirectly depend from claim 1, since claims 35-38 depend from claim 34, since claims 41 and 42 depend from claim 40, since claim 46 depends from claim 45, since claims 48-52, 54, 56-58 and 61-64 directly or indirectly depend from claim 47, since claims 81-85 depend from claim 80, since claims 87 and 88 depend from claim 86 and since claim 92 depends from claim 91, these claims are similarly not anticipated by the Werkhoven publication.

Note that embodiments consistent with the claimed invention advantageously provide security to an ad server over embodiments in which a browser requests ads directly from a content relevant ad server (since the ad server would communicate more directly with many clients, some of which may be hostile.). (See paragraph [0077] of the present application.)

Rejections under 35 U.S.C. § 103

Claims 24 and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Werkhoven publication.

Since claims 24 and 70 have been canceled, this ground of rejection is now moot.

New claims

New independent claims 93 and 94 are similar to the previous versions of claims 1 and 47 but are distinguished over the Werkhoven publication (which does not describe how it determines allegedly content-relevant ads) by reciting obtaining, by the web-based e-mail serving system, at least one ad relevant to the e-mail content, the at least one ad having been determined automatically using at least some of the e-mail content. New claims 93 and 94 are supported, for example, by FIG. 5 and paragraphs [0074]-[0076] and [0049] of the present application.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or

rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

November 3, 2009

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

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Signature

November 3, 2009
Date